The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte EARMA JOHNSON

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Appeal No. 2003-0221 Application 09/670,929

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ON BRIEF

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Before FRANKFORT, STAAB, and BAHR, <u>Administrative Patent Judges</u>.
FRANKFORT, <u>Administrative Patent Judge</u>.

## DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 7 and 12 through 16, which are all of the claims remaining in this application. Claims 8 through 11 have been canceled.

Appellant's invention relates to a container for holding and storing rolls of wrapping paper (claim 1) and a method of storing and holding individual rolls of wrapping paper (claim 12).

Independent claims 1 and 12 are representative of the subject matter on appeal and a copy of those claims, as reproduced from the Appendix to appellant's brief, is attached to this decision.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Schuster	4,941,624	July	17,	1990
Teasdale	4,969,595	Nov.	13,	1990
Marquez et al. (Marquez)	6,123,197	Sep.	26,	2000

Claims 1 through 3 and 7 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Teasdale.

Claims 1 and 15 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Schuster.

Claim 4 through 6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Teasdale in view of Official Notice.

Claims 12 through 14 and 16 stand rejected under 35 U.S.C. \$ 103(a) as being unpatentable over Schuster in view Marquez.

Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellant regarding those rejections, we make reference to the examiner's answer (Paper No. 13, mailed August 7, 2002) for the reasoning in support of the rejections, and to appellant's amended brief (Paper No. 12, filed July 16, 2002) for the arguments thereagainst.

## OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions

<sup>&</sup>lt;sup>1</sup> As noted on page 3 of the answer, the examiner has now removed or withdrawn the rejections of claims 12 through 13 relying on Enders in view of Marquez and that of claims 12 through 14 relying on Teasdale in view of Marquez as set forth in the final rejection (Paper No. 4).

articulated by appellant and the examiner. As a consequence of our review, we have made the determinations which follow.

Turning first to the examiner's rejection of claims 1 through 3 and 7 under 35 U.S.C. § 102(b) based on Teasdale, we note this patent discloses a container or carton which is convertible from one suitable for distribution of bulk goods (Fig. 3) to a carry-out tray (Figs. 5-7). It is clear from the explanation of the rejection (answer, page 3) and the examiner's comments on page 5 of the answer that the examiner is relying on the carton or container in the form shown, for example, in Figure 6 of Teasdale. As can be seen in Figure 6, the carton/container comprises a surrounding side structure (12, 13); a closed end defined by bottom flaps (15, 16); and an inlet end opposite the closed end, wherein the inlet end includes a shelf or support panel (34) having a series of openings (37) formed therein. is also apparent from Figure 6, the carton/container includes a holding area between the closed end and the shelf or support panel (34) and an open-topped side area or auxiliary storage area adjacent the shelf/support panel for holding additional items or materials.

Appellant's arguments against the examiner's use of Teasdale to reject claim 1 on appeal under 35 U.S.C. § 102(b) focus on the functional recitations of claim 1 regarding use of the container therein for holding rolls of wrapping paper. More particularly, appellant contends that the examiner has ignored the functional limitations in claim 1 and the accompanying structural limitations appertaining thereto. In light of the following commentary, we find these arguments to be unpersuasive.

An anticipation under 35 U.S.C. § 102(b) is established when a single prior art reference discloses, either expressly or under principles of inherency, each and every element or limitation of a claimed invention. See In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed Cir 1997) and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). However, we observe that the law of anticipation does not require that the reference teach what the appellant has disclosed but only that the claims on appeal "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See Kalman v. Kimberly Clark Corp., 713 F.2d 760, 772, 218 USPQ 871, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984). In the present case,

while it is true that there is nothing in the Teasdale patent which indicates that the carry-out container therein may be used for the storage of rolls of wrapping paper, we agree with the examiner that the carton/container of Teasdale (e.g., Fig. 6) is fully responsive to the structural features of the container set forth in claim 1 on appeal and is inherently capable of being used in the manner set forth in claim 1 to hold rolls of wrapping paper.

As was made clear in <u>In re Schreiber</u>, 128 F.3d at 1478, 44 USPQ2d at 1432, by choosing to define an element functionally as in appellant's claim 1 on appeal, appellant assumes a risk, that risk being that where the Patent and Trademark Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to <u>prove</u> that the subject matter shown to be in the prior art does not possess the characteristic relied upon. In the present case, appellant has provided no evidence to prove that the container in Teasdale is not capable of holding and storing appropriately sized rolls of wrapping paper. We therefore are constrained to agree with

the examiner that the differences in the intended use of the container seen in Teasdale Figure 6 and appellant's container do not patentably distinguish appellant's claimed container from the carton/container of Teasdale.

Since we find that the examiner has treated all of the limitations of claim 1 and agree with the examiner that the openings (37) in the shelf/support panel (34) of the container in Teasdale are sized to receive an appropriately sized roll of wrapping paper and that the holding area and support panel of Teasdale would permit individual rolls of such wrapping paper to extend from the support panel through the holding area while a portion of the rolls of wrapping paper are supported in the openings formed in the support panel, we will sustain the examiner's rejection of claim 1 under 35 U.S.C. § 102(b) as being anticipated by Teasdale.

In light of appellant's grouping of the claims as set forth on page 3 of the brief (Group 1), it follows that claims 2, 3 and 7 will fall with claim 1 and that the examiner's rejection of those claims under 35 U.S.C. § 102(b) will also be sustained.

The next rejection for our review is that of claims 1 and 15 under 35 U.S.C. § 102(b) as being anticipated by Schuster. In this instance, the examiner is of the view that Schuster discloses a container as claimed with a foldable support panel (12) including a plurality of openings (14, 74) therein to receive cylindrical objects. As can be seen best in Figures 1 and 4, the support panel (12) extends from a sidewall portion (20) of the container, spans across an inlet opening thereof, and includes a terminal edge having means (50, 54) associated therewith for connecting the terminal edge to the opposite side of the container.

Appellant's arguments regarding claim 1 again urge that the examiner has ignored or disregarded all of the functional limitations of the claim and that the rejection of this claim should be reversed on that basis. With respect to claim 15, appellant asserts that this claim includes a means plus function element and that the examiner has failed to properly address that limitation. More particularly, appellant contends (brief, page 11) that the corresponding means pointed to by the examiner in Schuster is not equivalent to the adhesive strip (28) shown in appellant's drawings and discussed in the specification.

For the same reasons as set forth above in our discussion of the examiner's rejection of claim 1 based on Teasdale, we share the examiner's view that the carton/container of Schuster is fully responsive to the structural features of the container set forth in claim 1 on appeal and is inherently capable of being used in the manner set forth in claim 1 to hold rolls of wrapping paper. In that regard, we consider that the openings (14, 74) in the support panel (12) of the container in Schuster are sized to receive an appropriately sized roll of wrapping paper and that the holding area and support panel of Schuster would permit individual rolls of such wrapping paper to extend from the support panel through the holding area while a portion of the rolls of wrapping paper are supported in the openings formed in the support panel. Appellant has not provided any evidence to prove that the container in Schuster is not capable of holding and storing appropriately sized rolls of wrapping paper.

As for claim 15, we share the examiner's view, as set forth on page 6 of the answer, that appellant's specification (page 4) broadly indicates that attaching edge (28) of the support panel (24) is provided with "some means" to secure the panel (24) to the container, and that such broad recitation supports the

examiner's broad reading of the means clause in claim 15. The fact that appellant then sets forth "one preferred embodiment" utilizing an adhesive strip that enables the attaching edge (28) to be secured to the upper edge of the opposed side (12) of the container does nothing to change our view that the means clause of claim 15 should be broadly construed. Moreover, we note that in column 6, lines 3-11, Schuster indicates that the strips (26) and (48) could be "glued together instead of being mechanically interlocked," or that both a mechanical locking arrangement and glue could be employed together.

As a result of the foregoing, we find appellant's arguments unpersuasive of error on the examiner's part and will sustain the examiner's rejection of claims 1 and 15 under 35 U.S.C. § 102(b) as being anticipated by Schuster.

Regarding the examiner's rejection of claims 4 through 6 under 35 U.S.C. § 103(a) as being unpatentable over Teasdale in view of Official Notice, we share appellant's view as set forth on page 12 of the brief, that appellant seasonably challenged the examiner's position on Official Notice with respect to use of an adhesive strip in the particular manner required in claim 4 on

appeal by arguing in the response filed August 27, 2001 (Paper No. 3) that such a factual assertion was not properly Officially Noticed. In our view, appellant's traversal of the rejection of claim 4 and express assertion in Paper No. 3 that it was not conceded that use of an adhesive strip in the manner set forth in claim 4 on appeal is notoriously old or common, operates as both a challenge to the examiner's position and a demand for proper evidence to support the obviousness rejection.

Since the examiner has failed to provide any documentary evidence to show that use of an adhesive strip in the manner required in claim 4 on appeal was old and well known in the art at the time of appellant's invention and that it would have been obvious to one of ordinary skill in the art to so use such an adhesive strip on the shelf or support panel (34) in the container of Teasdale, we are compelled to reverse the examiner's rejection of claim 4 based on Teasdale and Official Notice.

However, we find no challenge by appellant in Paper No. 3 regarding the examiner's use of Official Notice concerning the limitations of claims 5 and 6 on appeal, i.e., with regard to having more than one row of openings on a support panel like that

in Teasdale for holding articles, and that it would have been obvious to select an appropriate material, such as corrugated board, to make the container of Teasdale. Accordingly, we share the examiner's view concerning claims 5 and 6, finding that appellant has failed to seasonably challenge the examiner's position regarding the rejection of claims 5 and 6, and that the facts Officially Noticed are now taken to be admitted prior art. Moreover, we note that the carry-out carton or container seen in Figure 7 of Teasdale appears to include support panels (34) having or defining two rows of openings and that the container of Teasdale is specifically indicated to be formed of "heavier weight paperboard" (col. 2, lines 5-6) suitable for forming bulk goods cartons. Thus, we will sustain the examiner's rejection of claims 5 and 6 under 35 U.S.C. § 103(a).

The last rejection for our review is that of claims 12 through 14 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Schuster in view Marquez. In this instance, it appears to be the examiner's position with regard to method claims 12 through 14 and 16 that it would have been obvious to one of ordinary skill in the art at the time of appellant's invention, based on the gift wrapping storage container of Marquez, to store

a plurality of rolls of material (i.e., rolls of wrapping paper) in the cylindrical openings of the top panel (12) in Schuster's wrap-around bottle carrier/container to allow the user to retrieve the articles more easily. Like appellant, we find no motivation, teaching or suggestion in the collective disclosures of Schuster and Marquez which would have led one of ordinary skill in the art to perform the method as set forth in appellant's claims 12 through 14 and 16 on appeal and to utilize the wrap-around bottle carrier of Schuster as a container for holding and storing rolls of wrapping paper by inserting rolls of wrapping paper through the openings (14, 74) in the top panel (12) of the bottle carrier and into the container/carrier. Thus, we are constrained to reverse the examiner's rejection of claims 12 through 14 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Schuster in view Marquez.

In summary, the examiner's rejection of claims 1 through 3 and 7 under 35 U.S.C. § 102(b) as being anticipated by Teasdale has been sustained, as has the examiner's rejection of claims 1 and 15 under 35 U.S.C. § 102(b) as being anticipated by Schuster. In addition, the examiner's rejection of claims 5 and 6 under 35 U.S.C. § 103(a) has been sustained, but not the rejection of

claim 4, or the rejection of claims 12 through 14 and 16 under 35 U.S.C.  $\S$  103(a).

The decision of the examiner is accordingly affirmed-inpart.

In addition, we REMAND this application to the examiner to consider a rejection of claims 3 and 4 under 35 U.S.C. § 102(b) based on Schuster, noting that the top panel (12) of Schuster's container is a support panel that is foldably connected to the surrounding side structure and has a connecting terminal edge that is securable to an opposite portion of the surrounding side structure by way of glue or adhesive (Schuster, col. 6, lines 7-11).

In addition to affirming the examiner's rejection of one or more claims, this decision contains a remand. 37 CFR § 1.196(e) provides that

whenever a decision of the Board of Patent Appeals and Interferences includes or allows a remand, that decision shall not be considered a final decision. When appropriate, upon conclusion of proceedings on remand before the examiner, the Board of Patent Appeals and Interferences may enter an order otherwise making its decision final.

Regarding any affirmed rejection, 37 CFR § 1.196(b) provides:

Appellant may file a single request for rehearing within two months from the date of the original decision. . .

The effective date of the affirmance in this case is deferred until conclusion of the proceedings before the examiner unless, as a mere incident to the limited proceedings, the affirmed rejections are overcome. If the proceedings before the examiner does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejections, including any timely request for rehearing thereof.

This application, by virtue of it's "special" status, requires immediate action, see MPEP § 708.01.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR \$ 1.136(a).

## AFFIRMED-IN-PART AND REMANDED

CHARLES E. FRANKFORT Administrative Patent Jud	) dae )
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LAWRENCE J. STAAB	) BOARD OF PATENT
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## <u>APPENDIX</u>

- 1. A container for holding rolls of wrapping paper comprising: a surrounding side structure; a closed end; an inlet end formed on the container opposite the closed end through which rolls of wrapping paper are inserted, the inlet end including a support panel having a series of openings formed therein with each opening being sized to receive a roll of wrapping paper; and wherein there is defined a wrapping paper holding area between the closed end and the support panel that permits individual rolls of wrapping paper to extend from the support panel through the holding area while a portion of the rolls of wrapping paper are supported in the openings formed in the support panel.
- 12. A method of storing and holding individual rolls of wrapping paper comprising: forming a container having a surrounding side structure and an opening formed therein; placing an insert panel over the opening, the insert panel including a series of openings with each opening being sized to receive a roll of wrapping paper; inserting a plurality of individual rolls of wrapping paper through the openings of the insert panel and into the container.